



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,432	04/12/2004	Jean-Luc Collet	FR920030018US1	2549

23550 7590 03/06/2008
HOFFMAN WARNICK & D'ALESSANDRO, LLC
75 STATE STREET
14TH FLOOR
ALBANY, NY 12207

EXAMINER	
MADAMBA, GLENFORD J	

ART UNIT	PAPER NUMBER
2151	

NOTIFICATION DATE	DELIVERY MODE
03/06/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

Office Action Summary	Application No. 10/822,432	Applicant(s) COLLET ET AL.	
	Examiner Glenford Madamba	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to remarks and claim amendments filed by Applicant's representative on December 9, 2007.

Response to Remarks and Amendments

2. Applicant's remarks and claim amendments filed on December 9, 2007 have been considered but are now moot in light of the new grounds of rejection provided with this action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen, U.S. Patent 5,870,548 in view of Leonard et al (hereinafter Leonard), U.S. Patent 6,721,784.

As per Claim 1, Nielsen in view of Leonard discloses a system for enabling the cancellation of a previously-sent e-mail [Abstract], comprising a data transmission network, wherein a plurality of users are connected to said network [Figs. 1a-b & 2], each of said users being able as a sender (200) to send an e-mail (i.e., 'email') over said network to a plurality of users as recipients connected to said network (202), and wherein a message transfer agent (MTA) (203/207) is associated with each of said users for sending the e-mail when said user acts as a sender and delivering the e-mail when said user acts as a recipient [Fig. 2],

wherein each MTA includes a cancel mailbox (e.g., sender's outbox_204) for transmitting a cancellation message (i.e., "cancellation message") [col 4, L37-47] to said recipients when the user associated with said MTA is a sender wanting to cancel a previously-sent e-mail (i.e., "previously sent email") or for managing the cancellation of e-mails in the mailbox of the user associated with said MTA upon receiving said cancellation message from said sender when this user is a recipient [col 3, L5-50] [col 3, L56 – col 4, L3],

wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said email [Leonard: Abstract] [col 1, L60-62] [col 5, L40 – col 6, L10] [col 10, L19-28].

While Nielsen discloses substantial features of the invention such as the system of claim 1, the added feature of the process wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said email. is expressly disclosed by Leonard in a related endeavor.

Leonard discloses as his invention an electronic mail system and method in which the originator or sender may control the lifespan of the message, so that the message, and all copies of the messages everywhere in the world, disappear at an appropriate time [col 9, L10-15]. In particular, Leonard discloses the added feature of the process wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said email. (e.g., tracking the messages of "individuals or groups of recipients" to whom the message have been sent) [Abstract] [col 1, L60-62] (e.g., groups of clients) [col 5, L40 – col 6, L10] [col 10, L19-28]. As disclosed and taught by Leonard, a 'recipient' of the electronic messaging or mail system may be embodied as an 'individual recipient' or a 'group of recipients', the electronic mail system tracking information concerning the usage (i.e., message 'read' and/or 'deleted') and handling of the message by all recipients.

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Nielsen's invention with the above additional feature, as disclosed by Leonard, for the motivation of providing an electronic mail

system and method that enables the originator of a message sent by the electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct regardless of the number and types of computers or software systems that may have interacted with the message, and/or to include processing and handling limitations [Abstract].

As per claim 2, Nielsen discloses the system according to claim 1, wherein there is at least an intermediate MTA between the MTA associated with said sender and said MTA associated with said recipients (e.g., 167) [Fig. 1a], said intermediate MTA including a cancel mailbox (e.g., sender's outbox_204) [Fig. 2] in charge of transmitting a cancellation message to said MTAs associated to said recipients upon receiving said cancellation message from said MTA associated with said sender (i.e., "cancellation message") [col 4, L37-47] [Figs. 1a-b & 2].

As per claim 3, Nielsen discloses the system according to claim 1, wherein the cancel mailbox in each said MTA is associated with a cancellation agent for managing the cancellation of said e-mail; said cancellation agent building a delete process table giving a status of said e-mail during the cancellation process managed by said cancellation agent (e.g., 863 / 865) [Fig. 8D] (e.g., 'Delete Effected Message_1017') [Fig. 10a].

As per claim 4, Nielsen in view of Leonard discloses a process for canceling a previously-sent e-mail in a system comprising a data transmission network, wherein a

Art Unit: 2151

plurality of users are connected to said network, each of said users being able as a sender to forward an e-mail over said network to a plurality of users as a recipient connected to said network, and wherein a message transfer agent (MTA) is associated with each of said users for sending the e-mail when said user acts as a sender and delivering the e-mail when said user acts as a recipient [col 3, L5-50] [col 3, L56 – col 4, L3] [Figs. 1a-b & 2]; said process comprising:

a) sending from said sender a message for deleting said e-mail to a cancel mailbox included in said sender MTA (409) [Fig. 4],

b) sending from said cancel mailbox included in the sender MTA a message to a cancel mailbox included in each MTA respectively associated with each recipient being addressed in said e-mail in order to inform the recipients that said e-mail has to be deleted if it is not yet read (1011 & 1017) [Fig. 10a] [col 4, L38-42],

c) sending from said cancel mailboxes of said MTAs respectively associated with said recipients a message requesting that said e-mail has to be masked only if it has not yet been read (1011 & 1017) [Fig. 10a] [col 4, L38-42], and

d) deleting said masked e-mail only when none of said recipients has read said e-mail (1011 & 1017) [Fig. 10a] [col 4, L38-42], and not deleting the masked e-mail when any of said recipients has read said e-mail.

While Nielsen discloses substantial features of the invention such as the system of claim 1, the added feature of the process deleting said masked e-mail only when

none of said recipients has read said e-mail, and not deleting the masked e-mail when any of said recipients has read said e-mail is expressly disclosed by Leonard in a related endeavor.

Leonard discloses as his invention an electronic mail system and method in which the originator or sender may control the lifespan of the message, so that the message, and all copies of the messages everywhere in the world, disappear at an appropriate time [col 9, L10-15]. In particular, Leonard discloses the added feature of the process deleting said masked e-mail only when none of said recipients has read said e-mail, and not deleting the masked e-mail when any of said recipients has read said e-mail (e.g., tracking the messages of "individuals or groups of recipients" to whom the message have been sent) [Abstract] [col 1, L60-62] (e.g., groups of clients) [col 5, L40 – col 6, L10] [col 10, L19-28]. As disclosed and taught by Leonard, a 'recipient' of the electronic messaging or mail system may be embodied as an 'individual recipient' or a 'group of recipients', the electronic mail system tracking information concerning the usage (i.e., message 'read' and/or 'deleted') and handling of the message by all recipients.

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Nielsen's invention with the above additional feature, as disclosed by Leonard, for the motivation of providing an electronic mail system and method that enables the originator of a message sent by the electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct regardless of the number and types of computers or software

systems that may have interacted with the message, and/or to include processing and handling limitations [Abstract].

As per claim 5, Nielsen discloses a process according to claim 4, wherein a cancel mailbox of a MTA associated with each recipient sends back an acknowledgement message (e.g., confirmation message) of a first type if said recipient has not yet read said e-mail (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a].

As per claim 6, Nielsen discloses process according to claim 5, wherein the cancel mailbox of the MTA associated with several recipients sends back a first type message to said sender MTA if none of these recipients has already read said e-mail (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a].

As per claim 7, Nielsen discloses the process according to claim 6, wherein said step d) comprises sending from the cancel mailbox of said sender MTA a message to the cancel mailboxes of the MTAs associated with all the recipients addressed in said e-mail requesting each cancel mailbox to delete said e-mail (e.g., "Informing Recipient to Cancel the Message") [Fig. 6c].

As per claim 8, Nielsen discloses the process according to claim 7, wherein said step d) further comprises the step of sending a message from said cancel mailboxes of the MTAs associated with all recipients to the recipient mailboxes in order to delete said e-

mail (e.g., "Informing Recipient to Cancel the Message") [Fig. 6c].

As per claim 9, Nielsen discloses the process according to claim 7, wherein the cancel mailbox of said sender MTA sends a first type acknowledgment message to the mailbox of said sender to confirm that said e-mail has been deleted (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a].

As per claim 10, Nielsen discloses the process according to claim 4, wherein a cancel mailbox of a MTA associated with a recipient sends back an acknowledgment message of a second type if said recipient has already read said e-mail (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a] [col 4, L38-42].

As per claim 11, Nielsen discloses the process according to claim 10, wherein the cancel mailbox of the MTA associated with several recipients sends back a second type message to said sender MTA if at least one of these recipients has already read said e-mail (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a] [col 4, L38-42].

As per claim 12, Nielsen discloses the process according to claim 11, wherein said step d) comprises sending from the cancel mailbox of said sender MTA a message to the cancel mailboxes of the MTAs associated with the recipients who have not yet read said

Art Unit: 2151

e-mail requesting not to delete said e-mail (513 / 623) [Figs. 5 & 6c].

As per claim 13, Nielsen discloses the process according to claim 12, wherein said step d) further comprises the step of sending a message from said cancel mailboxes of the MTAs associated with the recipients who have not yet read said e-mail to the mailboxes of said recipients in order not to delete said e-mail (513 / 623) [Figs. 5 & 6c].

As per claim 14, Nielsen discloses the process according to claim 12, wherein the cancel mailbox of said sender MTA sends a second type acknowledgment message to the mailbox of said sender to confirm that said e-mail has not been deleted (e.g., confirmation message) [Figs. 9 & 10a].

As per claim 15, Nielsen discloses the process according to claim 4, wherein there is at least one intermediate MTA between said sender MTA and the MTAs associated with said recipients, said intermediate MTA being adapted to repeat any message received from the cancel mailbox of the sender MTA or from the cancel mailbox of any other MTA (167) [Fig. 1a].

As per claim 16, Nielsen in view of Leonard discloses the process according to claim 15, wherein at least one of said recipients is addressed by an alias, the cancel mailbox of the MTA receiving said alias being adapted to send a request to an associated domain name server (DNS) in order to obtain the address corresponding to said alias.

While Nielsen discloses substantial features of the invention such as the system of claim 1, the added feature of the process wherein at least one of said recipients is addressed by an alias, the cancel mailbox of the MTA receiving said alias being adapted to send a request to an associated domain name server (DNS) in order to obtain the address corresponding to said alias is disclosed by Leonard in a related endeavor.

Leonard discloses as his invention an electronic mail system and method in which the originator or sender may control the lifespan of the message, so that the message, and all copies of the messages everywhere in the world, disappear at an appropriate time [col 9, L10-15]. In particular, Leonard discloses the added feature of the process wherein at least one of said recipients is addressed by an alias, the cancel mailbox of the MTA receiving said alias being adapted to send a request to an associated domain name server (DNS) in order to obtain the address corresponding to said alias [col 1, L60-62] [col 5, L40 – col 6, L10] (e.g., DNS registration system and 'assigned' recipient address or alias address) [col 15, L37 – col 16, L10]. As disclosed and taught by Leonard, a 'recipient' of the electronic messaging or mail system may be embodied as an 'individual recipient' or a 'group of recipients', the electronic mail system tracking information concerning the usage (i.e., message 'read' and/or 'deleted') and handling of the message by all recipients.

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Nielsen's invention with the above added feature,

Art Unit: 2151

as disclosed by Leonard, for the motivation of providing an electronic mail system and method that enables the originator of a message sent by the electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct regardless of the number and types of computers or software systems that may have interacted with the message, and/or to include processing and handling limitations [Abstract]

Conclusion


1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.06(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenford Madamba whose telephone number is 571-272-7989. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Wallace Martin can be reached on 571-272-3440. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Follansbee
SPE 2151


Glenford Madamba
Examiner
Art Unit 2151